

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 24, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Stencil Ease, Inc.**

Serial No. 74/**519,518**

Robert H. Montgomery for applicant.

Caryn L. Hines, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Stencil Ease, Inc. to
register the mark SPILL PROOF for "creamy solid stencil
paint for interior use."¹

The Trademark Examining Attorney has refused
registration under Section 2(e)(1) of the Act on the ground

¹ Application Serial No. 74/519,518, filed May 3, 1994, alleging
dates of first use of May 31, 1992.

that applicant's mark, when applied to applicant's goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.²

The essence of the Examining Attorney's refusal is summed up in her own words (brief, p. 4):

The proposed mark is a widely used term to describe an attribute of liquids and the containers of these liquids. See the *Lexis/Nexis* attachments to the Office action mailed September 10, 1996. The proposed mark, "SPILL PROOF[,]" describes a feature of the container for the paint and this feature is that the containers enable the paint to be poured without spills. The applicant argues that the proposed mark is not descriptive, however, the applicant had something in mind when it chose its trademark. And further "spill proof" does has [sic] a meaning as applied to a feature of the goods. It is important to note that the applicant has not stated otherwise nor has it stated what it meant by naming the goods "SPILL PROOF." The wording "spill proof" as applied to the paint does not have meaning in that fluid or liquid paint cannot be manufactured to be "spill proof," but its containers can be made as such. Clearly, the wording "spill proof" has a definite meaning as applied to the containers for the paint which are inseparable

² The final refusal appears also to raise the issue of genericness for the first time. Although the Examining Attorney, in her brief, devoted about one page to a genericness argument, she went on to conclude, quite properly, that "the only issue now on appeal is whether the mark is merely descriptive, not generic" and that the Board need not decide the issue of genericness.

from the goods in that paint cannot be sold without a vessel of some type....Although fluids cannot be made "spill proof," the vessels in which they are contained can be....Containers of paint that are "spill proof" can be desirous and create an incentive to purchase the goods.

In support of her position, the Examining Attorney submitted the aforementioned excerpts retrieved from the NEXIS database, as well as copies of third-party registrations wherein the term "spill proof" appears in the identification of goods (as, for example, "spill-proof cup").

Applicant, in urging that the refusal be reversed, begins by pointing out that the mere descriptiveness refusal was not raised until the third Office action. Applicant contends that the Examining Attorney's reasoning is "total conjecture, very obtuse and not based on fact." Applicant essentially argues that its application covers paint, not containers, and that, therefore, the mark has not been shown to be merely descriptive. In making its arguments, applicant points to the Office's issuance of a third-party registration of the mark SPIL-PRUF for resinous coatings.

A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or

characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also: *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986).

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). We must reverse in this case due to the wholly inadequate record upon which the refusal to register is based.

So as to be clear on one point at the outset, the Examining Attorney does not contend that the mark is merely descriptive of applicant's paint, but rather contends that the mark describes the container in which the paint is sold. Relative to this point, the Examining Attorney

opined, as noted earlier, that "[t]he wording 'spill proof' as applied to the paint does *not* have meaning in that fluid or liquid paint *cannot* be manufactured to be 'spill proof,' but its containers can be made as such." (brief, p. 4)(emphasis added)³

We thus focus our attention on the Examining Attorney's contention that the term SPILL PROOF merely describes a feature of the container for applicant's product. This contention is based, unfortunately, on assumptions that have no factual basis. The NEXIS evidence refers to containers such as coffee mugs, bottles and bowls, and the third-party registrations are for the containers per se. In only a few instances are there any references to liquids being sold in a "spill proof" container (a bottle of fragrance for children, a bottle of nail polish, a bottle of a children's beverage and "toys, namely spill-proof, self contained bottles containing

³ We have questions about the Examining Attorney's view inasmuch as she seems to ignore the fact that the identification of goods reads "creamy *solid* stencil paint for interior use." This might lead one to conclude that the goods, not in truly liquid form, are not capable of being spilled or dripped, that is, that the paint is "spill proof." Nonetheless, the Examining Attorney never argued as such, but rather consistently maintained that the mark cannot be descriptive of the paint itself. Accordingly, and since the record is devoid of any evidence whatsoever bearing on applicant's paint or similar products, the Board has no factual basis upon which to find that SPILL PROOF is merely descriptive of stencil paint which cannot be spilled.

paint"). Conspicuously absent in the record is any evidence that the term "spill proof" has been used to refer to a product and/or product container of the specific type of applicant's. See: In re Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1995)[the fact that a term may be descriptive of certain goods is not determinative of whether it is descriptive of other goods, even if the goods are closely related]. Even when considering the paint product and container as an integral unit for sale, as the Examining Attorney has done, there simply is no evidence that **applicant's** container is "spill proof" or that the term has been used to describe similar goods. Based on the sparse record, we are unable to conclude that purchasers, upon seeing the mark on applicant's product, would immediately understand the mark as describing a significant feature of the product, namely, that the product is sold in a container which prevents spillage. Simply put, the Examining Attorney has failed to establish, with probative evidence, that the mark is merely descriptive when applied to applicant's goods.

In deciding this issue, we have given little weight to the Office's issuance of a Principal Register registration to a third party for the mark SPIL-PRUF for "coating materials, namely, synthetic resinous coatings for

application to wood, cloth, paper and metal." Suffice it to say that each case must be decided on its own set of facts.

We would be remiss if we did not offer one final thought. We are at a loss to understand why, in cases where a refusal is made under Section 2(e)(1) (especially involving use-based applications as is the situation here), the Office does not, as a matter of course, request product information from the applicant. See: *Trademark Manual of Examining Procedure*, § 1105.02. Such information often is very helpful in resolving the often close call between suggestive and merely descriptive marks. The specimens in the present application do not shed light on the issue before us, but if product literature were of record here, the Examining Attorney might well have had the benefit of certain facts regarding applicant's paint and/or containers therefor, as opposed to having been confined to mere speculation.

This is a classic case where the Board's decision is driven by a record which is, quite frankly, lacking. The clear shortcomings of the record, at the very least, create doubts on the issue of whether the mark is merely descriptive as applied to the goods. In this situation, the Board must resolve doubts in applicant's favor with the

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knowledge that any third party is free to file an opposition and develop a more comprehensive record. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972). In the present case, it is quite possible that on a fully developed record, a different result may be reached.

Decision: The refusal to register is reversed.

E. J. Seeherman

T. J. Quinn

C. E. Walters
Administrative Trademark
Judges, Trademark Trial
And Appeal Board

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